



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,013	05/04/2001	Patrick Man Ning Wong	A33902-072119.0110	9521

21003 7590 07/05/2006

BAKER & BOTTS
30 ROCKEFELLER PLAZA
44TH FLOOR
NEW YORK, NY 10112

EXAMINER

COLBERT, ELLA

ART UNIT PAPER NUMBER

3693

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/849,013	Applicant(s) WONG ET AL.	
	Examiner Ella Colbert	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/03/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-6 are pending in this communication filed 05/04/01.
2. The IDS filed 08/03/01 has been reviewed and entered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 2002/0099640) Lange. Priority date (7/21/99 –provisional application no. 60/144,890)

Claim 1. Lange discloses, A method for providing customized derivative securities comprising: receiving from an investor data regarding a desired risk-return values and selection of at least one issuer of traded securities (Page 34, col. 2 [0468]-[0470]); structuring a customized security having at least one of said desired risk-return value and comprising a derivative security having at least one component related to said traded securities of said issuer and at least one other component (page 34, col. 2 [0471]-page 35, col.2, line 2, and page 39, col. 2 [0528]); pricing said customized security according to current market prices for said components (page 40, col. 2 [0536]); and offering said customized security to said investor (page 34, col. 1 [0453]). Lange did not expressly disclose that an offer was made. However, it would have been obvious to make an offer to an investor of a security because securities are frequently

offered to investor in the hope that the investor will purchase the security and add it to their portfolio.

Claim 2. Lange discloses, A method as specified in claim 1 wherein said component related to traded securities comprises a component selected from the group comprising a long share component, a short share component, a long put option, a short put option, a long call option and a short call option (page 2,col. 1 [0013]-col. 2, line 7, page 4, col. 1 [0037], and page 34, col. 1 [0453]).

Claim 3. Lange discloses, A method as specified in claim 2 wherein said at least other component comprises a loan or a bond (page 28, col. 2 [0360]-page 28, col. 1 [0384]).

Claim 4. Lange discloses, A method as specified in claim 1 further comprising receiving an acceptance for said customized security from said investor and covering the position by trading said components in amounts corresponding to their inclusion in said customized derivative security (page 31, col. 1 [0413], page 33, col. 1 [0441]-col. 2 [0446], page 35, col. 1 [0472]-col. 2 [0477])..

Claim 5. Lange discloses A method as specified in claim 1 wherein said structuring includes selecting relative amounts of said components of said customized securities to achieve one of said risk-return values specified by said investor (page 34, col. 2 [0469]-[0470]).

Claim 6. Lange discloses A method as specified in claim 5 wherein said risk return values are normalized to selected standard risk-return values (page 29, col. 2 [0386]-[0388]).

Conclusion

Art Unit: 3624

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Makivic (US 6,061,662) disclosed financial instruments such as derivative securities.

Inquiries

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Tuesday-Thursday, 6:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

June 24, 2006


ELLA COLBERT
PRIMARY EXAMINER